

### **REMARKS**

This amendment is submitted in reply to the Office Action dated November 1, 2007. Claims 11-15 currently stand rejected. Claims 1-5 have been previously withdrawn as a result of a restriction requirement. Independent claims 11 and 12 have been amended to incorporate the subject matter of claims 14 and 15, respectively, which have been canceled as a result. New claims 16-19 have been added to further define patentable aspects of the invention. No new matter has been added by the amendment.

In light of the amendments and the remarks presented below, Applicants respectfully request reconsideration and allowance of all now-pending claims of the present application.

#### **Claim Rejections Under 35 U.S.C. §112**

Claims 11-15 were rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, the Office Action asserts that claims 11 and 12 omit essential steps. Of note, although the second paragraph on page 2 of the Office Action refers to the omitted elements being “the first user”, Applicants believe this paragraph to be included by mistake as there is no apparent reason for “the first user” to be in any way associated with the claimed invention. Applicants believe the third paragraph to have been the only intended paragraph for inclusion in the Office Action and therefore are only responding to the third paragraph on page 2 of the Office Action. If the Examiner believes “the first user” to be an essential element, Applicants respectfully request a more clear explanation of how such phrase is deemed essential.

With regard to the third paragraph on page 2 of the Office Action, which asserts that a determination that a digital music file has a higher probability of being reproduced, Applicants respectfully disagree that such element is missing based on the implicit recitations of claims 11 and 12. However, in an effort to further prosecution, Applicants have incorporated the subject matter of claims 14 and 15, which define how a determination that a digital music file has a higher probability of being reproduced is made, into independent claims 11 and 12, respectively. Claims 14 and 15 have therefore been canceled, without prejudice. Thus, the rejections of claims

14 and 15 are moot and the rejections of claims 11 and 12, as well as dependent claim 13, under 35 U.S.C. §112, second paragraph, are overcome.

**Claim Rejections - 35 U.S.C. §102**

Claims 11-13 currently stand rejected under 35 U.S.C. §103(s), as being unpatentable over Hale et al. (U.S. Patent No. 6,732,180, hereinafter "Hale") in view of Rabin et al. (U.S. Patent No. 6,697,948, hereinafter "Rabin"). Claims 14 and 15 currently stand rejected under 35 U.S.C. §103(a) as being unpatentable over Hale and Rabin and further in view of Hunter et al. (U.S. Patent No. 7,209,900, hereinafter "Hunter"). As indicated above, claims 14 and 15 have been canceled and thus the rejections of these claims are now moot. However, the substance of the rejections of claims 14 and 15 will be dealt with below due to the incorporation of claims 14 and 15 into independent claims 11 and 12, respectively.

Independent claims 11 and 12 have been amended to recite, *inter alia*, determining a digital music file that has a higher probability of being reproduced by another user than other music files related to the digital music file illegally distributed through a computer communication network. The Office Action admits, and Applicants agree, that neither Hale nor Rabin provides any teaching or suggestion regarding determining which music files have a high probability of being copied. Accordingly, the Office Action relies upon Hunter for disclosing such feature. Applicants respectfully disagree.

In this regard, Hunter discloses at col. 10, lines 25-53 that music is divided into three tiers of transmission frequency. Music that is more popular is transmitted with greater frequency. Col. 13, line 65 to col. 14, line 30 of Hunter further describes how customer preference information and customer order information are used to create a personalized customer catalog to determine which recordings will be automatically downloaded to a user's station. In this regard, the customer catalog may overwrite less likely to be purchased recordings with recordings that "show more promise of being purchased." New release recordings in high demand within the user's primary area of interest may be designated to remain in intermediate storage for a predefined time period. However, Hunter never discusses anything about a particular music file having a high likelihood of being copied or reproduced, and particularly not being reproduced in

the context of illegal distribution of copies. To the contrary, Hunter only deals with distribution of music recordings for purchase.

Despite the fact that Applicants disagree with the assertion that Hunter determines which music files have a higher probability of being copied, Applicants further note that the claimed invention does not merely recite a determination with regard to which music file has a higher probability of being copied. In fact, such assertion oversimplifies the claimed invention. In this regard, the claimed invention provides that a digital music file having a higher probability of being reproduced by another user than other music files related to the digital music file is determined. As such, even if one were to take a very broad view of the term “reproduced”, by asserting that by purchasing a music recording, the user “reproduces” or receives a reproduction of the file, Hunter still fails to meet the claimed invention.

In this regard, independent claims 11 and 12 essentially provide that from among a plurality of related music files, a single file that is most likely to be reproduced is determined. In other words, of many versions of a particular file (i.e., related music files), one of the versions is selected based on which one is determined to be most likely to be copied. Meanwhile, the music recordings of Hunter cover many different songs or specific recordings, but do not provide any relationship between the songs to form the basis upon which one file is selected from the others on the basis of probability of being reproduced. As such, since the claimed invention provides for selection of one file from among files related to it, and Hunter only provides for selection of “popular” files from among all of the unrelated files corresponding to different songs, Hunter fails to teach or suggest determining a digital music file that has a higher probability of being reproduced by another user than other music files related to the digital music file illegally distributed through a computer communication network as recited in independent claims 11 and 12.

Of note, Hale refers to decoy media files, which one might argue are related to a particular file. However, Hale does not seek to determine one of the related files that is most likely to be reproduced, as admitted by the Office Action. Thus, even combining the decoy media files disclosed in Hale with the popularity concept of Hunter, one is still left short of the

claimed invention since, such combination yields a determination of which unrelated songs are popular and then the creation of decoy media or related files for each of the popular songs.

Since Hale, Rabin and Hunter each fail to teach or suggest determining a digital music file that has a higher probability of being reproduced by another user than other music files related to the digital music file illegally distributed through a computer communication network as recited in independent claims 11 and 12, any combination of Hale, Rabin and Hunter also fails to teach or suggest the above recited feature of independent claims 11 and 12. Thus, independent claims 11 and 12 are patentable and non-obvious in view of the cited references either alone or in combination. Claim 13 depends directly from independent claim 12 and thus includes all the recitations of independent claim 12. Therefore, dependent claim 13 is patentable for at least those reasons given above for independent claim 12.

Accordingly, for all the reasons above, Applicants respectfully submit that the rejections of claims 11-13 are overcome.

#### **Newly Added Claims**

Applicants have added new claims 16-19 to more particularly define aspects of the present application. The new claims include no new matter and are fully supported by the specification and the drawings of the present application.

Accordingly, it is believed that the new claims are in condition for allowance.

Appl. No.: 09/977,895  
Filed: October 15, 2001  
Amendment Dated January 18, 2008

### CONCLUSION

In view of the amendments and the remarks presented above, it is respectfully submitted that all of the claims are in condition for allowance. Accordingly, a Notice of Allowance is respectfully requested in due course. The Examiner is encouraged to contact Applicants' undersigned attorney to resolve any remaining issues in order to expedite examination of the present application. It is not believed that extensions of time or fees for net addition of claims are required, beyond those that may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 CFR § 1.136(a), and any fee required therefore (including fees for net addition of claims) is hereby authorized to be charged to Deposit Account No. 16-0605.

Respectfully submitted,



Chad L. Thorson  
Registration No. 55,675

**Customer No. 00826**  
**ALSTON & BIRD LLP**  
Bank of America Plaza  
101 South Tryon Street, Suite 4000  
Charlotte, NC 28280-4000  
Tel Charlotte Office (704) 444-1000  
Fax Charlotte Office (704) 444-1111

ELECTRONICALLY FILED USING THE EFS-WEB ELECTRONIC FILING SYSTEM OF THE UNITED STATES PATENT & TRADEMARK OFFICE ON JANUARY 18, 2008.  
LEGAL01/13071766v1